

## REMARKS

### **Summary of Amendments**

Upon entry of the present amendment claims 21 to 53 will remain pending, with claims 21, 34 and 53 being independent claims. Claim 34 has been amended to make it even clearer what a rheology control agent is. Support for this amendment can be found throughout the present specification and in particular, at page 11, last paragraph, page 1, second paragraph, and in Examples 2 and 3.

### **Summary of Office Action**

As an initial matter, Applicants note that an initialed and signed copy of the Form PTO 1449 submitted in the Information Disclosure Statement filed February 17, 2004 (together with the Amendment in response to the previous Office Action) was not attached to the present Office Action. Accordingly, Applicants respectfully request that a signed and initialed copy of this Form PTO 1449 be returned together with the next official communication from the Patent and Trademark Office.

Applicants note with appreciation that claims 21-33 and 53 are allowed and that claims 39, 40, 42, 45 and 50 are indicated to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicants also note with appreciation that the rejections under 35 U.S.C. § 112, first

P24821.A04

paragraph, and the rejection under 35 U.S.C. § 102(e) over U.S. Patent No. 6,538,092 to Terry et al. have been withdrawn.

Claims 34-38, 41, 43, 44, 46-49, 51 and 52 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by JP 62-230873 A (hereafter "JP '873").

### **Response to Office Action**

Withdrawal of the rejections of record is respectfully requested, in view of the foregoing amendment and the following remarks.

### ***Response to Rejection of Claims under 35 U.S.C. § 102(b) over JP '873***

Claims 34-38, 41, 43, 44, 46-49, 51 and 52 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by JP '873. In this regard, the Examiner does not accept Applicants arguments as to why the solvent described in JP'873 does not qualify as a rheology control agent as recited in present claim 34. In particular, the rejection essentially alleges that irrespective of whether a certain component influences the viscosity and flowability of a composition primarily or secondarily, this component (e.g., the solvent of JP'873) is a rheology control agent in the sense of the present claims. In view thereof, the rejection asserts that claim 34 and several of the claims dependent therefrom are anticipated by JP'873.

P24821.A04

In view of this rejection, claim 34 has been amended to make it even clearer what distinguishes a rheology control agent from a mere viscosity/flowability modifier (although Applicants believe this term to be readily understood on its own). In particular, claim 34 recites that the rheology control agent provides structural viscosity or thixotropy to the composition. In other words, the rheology control agent used in the composition of the present invention provides a non-Newtonian rheological behavior. Structural viscosity and thixotropy essentially describe the same property, but thixotropy also includes some kind of time dependency (hysteresis). While conventional solvents and fillers/pigments like those disclosed in JP'873 may be useful for reducing or increasing the viscosity of a composition, they are not rheology control agents in the sense of the present claims, i.e., they are not capable of providing structural viscosity or thixotropy. In addition, JP'873 does not appear to disclose any other materials which would be capable of acting as rheology control agents.

To sum up, the composition of JP'873 lacks a rheology control agent and for this reason alone, does not anticipate present claim 34 or any of the claims dependent therefrom. Accordingly, withdrawal of the rejection of the claims under 35 U.S.C. § 102(b) is warranted and respectfully requested.

Since JP'873 does not anticipate claim 34 for the foregoing reasons alone, there is no need to comment on the Examiner's remaining allegations, in particular, those relating to the catalytically active filler. It is pointed out, however, that Applicants' silence in this regard

P24821.A04

is by no means to be construed as Applicants' admission that any of these allegations are meritorious.

### CONCLUSION

In view of the foregoing, it is believed that all of the claims in this application are in condition for allowance, which action is respectfully requested. If any issues yet remain which can be resolved by a telephone conference, the Examiner is respectfully invited to telephone the undersigned at the telephone number below.

Respectfully submitted,  
Axel KALLEDER et al.



Neil F. Greenblum  
Reg. No. 28,394

Reg. No. 50,417

July 14, 2004  
GREENBLUM & BERNSTEIN, P.L.C.  
1950 Roland Clarke Place  
Reston, VA 20191  
(703) 716-1191